

ESTTA Tracking number: **ESTTA104657**

Filing date: **10/17/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91173189
Party	Defendant Logniko, Igor Logniko, Igor Apt. 2a, Brooklyn 7115 3rd Ave. , NY 11209
Correspondence Address	Jennifer M. Lantz MacPherson Kwok Chen & Heid LLP Suite 400, 2033 Gateway Place San Jose CA, 95110
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	RICHARD S. ROSS, ESQ.
Filer's e-mail	prodp@ix.netcom.com
Signature	/richard ross/
Date	10/17/2006
Attachments	Opp No. 91173189 motion to dismiss.pdf ( 22 pages )(544841 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 78/612,360    TEMPLATEMONSTER  
MONSTERCOMMERCE, LLC

Opposer,

v

Opposition No. 91173189

IGOR LOGNIKOV

Applicant.

---

**MOTION TO DISMISS FOR LACK OF SUBJECT MATTER JURISDICTION AND  
STANDING, AND FOR FAILURE TO STATE A CLAIM**

COMES NOW, the Applicant, IGOR LOGNIKOV (“Lognikov”), by and through his undersigned counsel, who respectfully moves this board to dismiss the pending opposition for lack of subject matter jurisdiction, and for failure to state a claim upon which relief can be granted. Fed.R.Civ.P. 12(b)(1); (6). The opposition was filed outside the time limits provided under the rules of practice, and thus, this board has no subject matter jurisdiction. Additionally, the Opposer, MONSTERCOMMERCE, LLC (“MC”), from the face of the opposition, does not own any right to U.S. Reg. No. 2,947,268, and thus has no standing to assert the opposition. For these reasons, the opposition should be dismissed for lack of subject matter jurisdiction, or failure to state a claim.

**I. FACTUAL BACKGROUND**

1. Lognikov filed for registration of the mark TEMPLATEMONSTER (“the TM mark”), Serial No. 78/612,360, on April 19, 2005. On May 30, 2006, the TM mark was published in the

*Official Gazette*, for potential opposition.

2. On June 16, 2006, Network Solutions, LLC (“NS”) filed a request for extension of time to oppose the TM mark. Also on June 16, 2006, the board granted the request until September 27, 2006.
3. The record evidences that MC never requested an extension of time to oppose the TM mark.
4. On September 27, 2006, MC filed the pending Notice of Opposition.
5. The record evidences that NS never timely filed a Notice of Opposition.
6. MC asserts in the opposition that it is the owner of U.S. Reg. No. 2,947,268, Exhibit A, for the mark MONSTERCOMMERCE. U.S. Reg. No. 2,947,268 evidences that that registration was not owned by MC at the time the present opposition was filed, but rather was owned by a separate legal entity Monstercommerce, **Inc.** (Emphasis Added).

## **II. LEGAL ARGUMENTS**

1. An attack on subject matter jurisdiction under Rule 12(b)(1) may be either facial or factual. *Commodity Futures Trading Com’n v. G7 Advisory Services, LLC*, 406 F. Supp.2d 1289, 1292 (S.D. Fla. 2005)(citations omitted). “Facial attacks on the complaint require[] the court merely to look and see if [the] plaintiff has sufficiently alleged a basis of subject matter jurisdiction, and the allegations in his complaint are taken as true for the purposes of the motion.” *Lawrence v. Dunbar*, 919 F.2d 1525, 1528-29 (11<sup>th</sup> Cir. 1990)(quotations, citations omitted). Conversely, factual attacks on jurisdiction challenge the existence of jurisdiction in fact, regardless of the pleadings. *See id.* at 1529. “[W]hen a defendant properly challenges subject matter jurisdiction under Rule 12(b)(1) the district court is free to independently weigh facts, and may proceed as it never could under Rule 12(b)(6) or Fed.R.Civ.P. 56.”

*Morrison v. Amway Corp.*, 323 F.3d 920, 925 (11<sup>th</sup> Cir. 2003).

2. Under Rule 12(b)(6), “[d]ismissal is appropriate where it is clear the plaintiff can prove no set of facts in support of the claims in the complaint. Accordingly, the court may dismiss a complaint pursuant to Federal Rule of Civil Procedure 12(b)(6) when, on the basis of a dispositive issue of law, no construction of the factual allegations will support the cause of action.” *Marshall County Bd. Of Educ. v. Marshall County Gas Dist.*, 992 F.2d 1171, 1174 (11<sup>th</sup> Cir. 1993)(citations omitted). “In ruling on the motion to dismiss the district court must accept the well pleaded facts as true and resolve them in the light most favorable to the plaintiff.” *St. Joseph’s Hosp., Inc. v. Hosp. Corp. Of America*, 795 F. 2d 948, 954 (11<sup>th</sup> Cir. 1986).
3. “Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, **within thirty days** after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered.” 15 U.S.C §1063(a)(Emphasis Added).
4. MC did not file the present opposition within thirty days after publication, and did not seek and extension of time to oppose. Therefore, the opposition is statutorily untimely and must be dismissed for lack of subject matter jurisdiction. To the extent MC attempts to rely on being a “subsidiary” of NS, there is insufficient “relatedness” to allow MC to benefit from NS’s extension of time request. “The term ‘related company’ means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.” 15 U.S.C. §1127. The

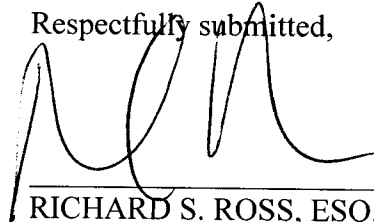
opposition does not allege that NS controls MC. *See* Opposition, preamble. Further, the opposition does not allege that MC is wholly owned by NS. *See American Petrofina , Inc. v. Petrofina of California, Inc.*, 189 U.S.P.Q. 67 (C.D. Cal. 1975), *aff'd* 596 F.2d 896, 202 U.S.P.Q. 354 (9<sup>th</sup> Cir. 1979); *R.C.W. Supervisor, Inc. v. Cuban Tobacco Co.*, 220 F. Supp. 453, 138 U.S.P.Q. 441 (S. D. N.Y. 1963); *Brown-Vintners Co. v. National Distillers & Chemical Corp.*, 151 F. Supp. 595, 114 U.S.P.Q. 483 (S.D.N.Y. 1957).

5. MC bases its untimely opposition on the ownership of U.S. Reg. No. 2,947,268. The record evidences that MC does not own that registration. Rather, it is owned by a separate company named Monstercommerce, Inc. That registration's records show that as of the filing of the opposition, Monstercommerce, Inc. was the owner of the MONSTERCOMMERCE mark, and not MC. Thus, MC has no standing to oppose the TM mark because it does not own the MONSTERCOMMERCE mark.
6. For the foregoing reasons, the opposition also fails to state a claim upon which relief can be granted. Because the opposition is untimely as to MC, and MC has no ownership interest in the MONSTERCOMMERCE mark as of the filing of the opposition, MC presents no claim upon which relief can be granted.

### **III. CONCLUSION**

WHEREFORE, Lognikov respectfully moves for an order dismissing the opposition.

Respectfully submitted,



RICHARD S. ROSS, ESQ.

Fla. Bar. No. 436630

Attorney for Applicant

4801 South University Drive

Suite 237

Ft. Lauderdale, Florida 33328

Tel (954) 252-9110

Fax (954) 252-9192

E mail [prodp@ix.netcom.com](mailto:prodp@ix.netcom.com)

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail, and addressed to counsel for the Opposer:

Brian J. Winterfeldt  
Tricia McDermott Thompkins  
Ballard Spahr Andrews & Ingersoll, LLP  
601 13<sup>th</sup> Street, NW,  
Suite 1000 South  
Washington, DC 20005

this 17<sup>th</sup> day of October, 2006.



Richard S. Ross, Esq.

## **EXHIBIT A**


**United States Patent and Trademark Office**

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**Trademarks > Trademark Electronic Search System(Tess)**

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[ASSIGN Status](#)
[TDR](#)
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Browser to return to TESS)

**Typed Drawing**

**Word Mark** **MONSTERCOMMERCE**

**Goods and Services** IC 042. US 100 101. G & S: computer services, namely, providing on-line non-downloadable software that enables users to sell their products or services on-line, namely, software facilitating the practicing of e-commerce services and e-commerce shopping portal services.  
FIRST USE: 20011005. FIRST USE IN COMMERCE: 20011005

**Mark Drawing Code** (1) TYPED DRAWING

**Design Search Code**

**Serial Number** 76445524

**Filing Date** August 29, 2002

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** March 25, 2003

**Registration Number** 2947268

**Registration Date** May 10, 2005

**Owner** (REGISTRANT) MONSTERCOMMERCE, INC. CORPORATION CALIFORNIA 10715 Norton Lane Sparta ILLINOIS 62286

**Assignment Recorded** ASSIGNMENT RECORDED



**Attorney of  
Record** H. JAY SPIEGEL  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Live/Dead  
Indicator** LIVE

<a href="#">TESS HOME</a>	<a href="#">NEW USER</a>	<a href="#">STRUCTURED</a>	<a href="#">FREE FORM</a>	<a href="#">BROWSE DICT</a>	<a href="#">SEARCH OG</a>	<a href="#">TOP</a>	<a href="#">HELP</a>	<a href="#">PREV LIST</a>	<a href="#">CURR LIST</a>
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**This page was generated by the TARR system on 2006-10-17 15:10:29 ET**

**Serial Number:** 76445524 Assignment Information

**Registration Number:** 2947268

**Mark (words only):** MONSTERCOMMERCE

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2005-05-10

**Filing Date:** 2002-08-29

**Transformed into a National Application:** No

**Registration Date:** 2005-05-10

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 114

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 830 -Post Registration

**Date In Location:** 2006-05-10

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#### LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MONSTERCOMMERCE, INC.

**Address:**

MONSTERCOMMERCE, INC.

10715 Norton Lane

Sparta, IL 62286

United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** California

**GOODS AND/OR SERVICES****International Class:** 042**Class Status:** Active

computer services, namely, providing on-line non-downloadable software that enables users to sell their products or services on-line, namely, software facilitating the practicing of e-commerce services and e-commerce shopping portal services

**Basis:** 1(a)**First Use Date:** 2001-10-05**First Use in Commerce Date:** 2001-10-05**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

**MADRID PROTOCOL INFORMATION**

(NOT AVAILABLE)

**PROSECUTION HISTORY**

2006-10-12 - PAPER RECEIVED

2006-07-26 - TEAS Change Of Correspondence Received

2006-05-10 - Post Registration action mailed - Section 7

2006-01-20 - Assigned To Paralegal

2005-10-27 - PAPER RECEIVED

2005-06-23 - PAPER RECEIVED

2005-05-10 - Registered - Principal Register

2005-02-02 - Opposition terminated for Proceeding

2005-02-02 - Opposition dismissed for Proceeding

2003-04-30 - Opposition instituted for Proceeding

2003-04-30 - Opposition papers filed

2003-03-25 - Published for opposition

2003-03-05 - Notice of publication

2003-01-13 - Approved for Pub - Principal Register (Initial exam)

2003-01-07 - Assigned To Examiner

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**CORRESPONDENCE INFORMATION**

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**Correspondent**

H. JAY SPIEGEL (Attorney of record)

Brian J. Winterfeldt  
Ballard Spahr Andrews & Ingersoll, LLP  
Suite 1000 South  
601 13th Street, N.W.  
Washington DC 20005-3807  
**Phone Number:** (202) 661-2200  
**Fax Number:** (202) 661-2299

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

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In re Registration of	:	
MonsterCommerce, LLC	:	POST REGISTRATION
Registration No.: 2,947,268	:	Trademark Specialist:
Registration Date: May 10, 2005	:	Valerie Stevens
Mark: MONSTERCOMMERCE	:	

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**RESPONSE**

Dear Madam:

This is submitted in response to the Post Registration Office Action dated May 11, 2006.

**DECLARATION**

The Trademark Specialist has rejected the Section 7(h) Request for Correction submitted on October 27, 2005 because an Affidavit under 37 C.F.R. §2.20 verifying the contents was not submitted. Applicant submits herewith as Exhibit A, the required Substitute Affidavit in Support of Ownership of Registration.

**REVOCATION AND POWER OF ATTORNEY WITH APPOINTMENT OF  
DOMESTIC REPRESENTATIVE**

Please note that a Revocation and Power of Attorney is also being filed today in connection with this registration, a copy of which is attached as Exhibit B.

**CONCLUSION**

The Registrant, MonsterCommerce, LLC, respectfully requests the amendment of the registration and notification to that effect be provided at the Trademark Office's earliest convenience. If further action of the part of the Registrant is required, the Trademark Specialist is invited to contact the undersigned.

Respectfully Submitted,

Date: October 12, 2006

By:



Brian J. Winterfeldt, Esq.  
Tricia M. Thompson, Esq.  
Ballard Spahr Andrews & Ingersoll, LLP  
601 13th Street, N.W.  
Suite 1000 South  
Washington, DC 20005-3807  
Telephone: 202.661.2200  
Facsimile: 202.661.2299

# **EXHIBIT A**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Registration of

MonsterCommerce, LLC

Reg. No.: 2,947,268

BOX POST REGISTRATION

Reg. Date: May 10, 2005

Mark: MONSTERCOMMERCE

**SUBSTITUTE AFFIDAVIT IN SUPPORT OF  
OWNERSHIP OF REGISTRATION**

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

To The Commissioner of Trademarks:

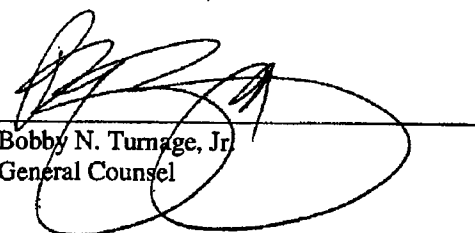
I, the undersigned, declare that the application as filed on August 29, 2002, and subsequently the registration as issued on May 10, 2005, which indicates the Applicant/Registrant as MonsterCommerce, Inc., a corporation of California is incorrect. The application and subsequent registration should indicate that the Applicant/Registrant is MonsterCommerce, LLC, a limited liability company of California.



MonsterCommerce, LLC  
Reg. No. 2,974,268

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that all statements made of her own knowledge are true all statements made on information and belief are believed to be true.

MonsterCommerce, LLC



Bobby N. Turnage, Jr.  
General Counsel

Date: October 5, 2006

# **EXHIBIT B**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
UNITED STATES DEPARTMENT OF COMMERCE**

Registrant: MonsterCommerce, LLC

Mark: MONSTERCOMMERCE

Reg. No.: 2,947,268

Registered: May 10, 2005

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REVOCATION AND POWER OF ATTORNEY**

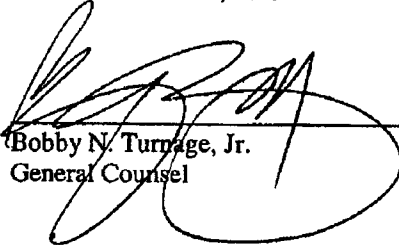
MonsterCommerce, LLC appoints Ballard Spahr Andrews & Ingersoll, LLP, 601 13<sup>th</sup> Street, N.W., Suite 1000 South, Washington, DC 20005 as its domestic representative upon whom all documents can be served involving matters and proceedings related to the mark identified above.

Applicant hereby appoints as its attorneys: **Brian J. Winterfeldt**, Deepika R. Allana, Benita P. Collier, Stacey J. Johnson, Tricia M. Thompson and all other attorneys with the firm of Ballard Spahr Andrews & Ingersoll, LLP, as principal attorneys to prosecute these applications, to transact all business in the U.S. Patent and Trademark Office connected therewith and to receive the Registration Certificates if one should issue. Please direct all communication to:

**Brian J. Winterfeldt, Esq.**  
Ballard Spahr Andrews & Ingersoll, LLP  
601 13<sup>th</sup> Street, N.W.  
Suite 1000 South  
Washington, DC 20005-3807  
Telephone: (202) 661-2200  
Facsimile: (202) 661-2299  
Email: winterfeldtb@ballardspahr.com

Applicant hereby revokes any and all previous Powers of Attorney filed in relation to this registration.

MonsterCommerce, LLC

  
Bobby N. Turnage, Jr.  
General Counsel

Date: October 5, 2006

Document Description: **Status Letter for Registration No.**  
 Mail / Create Date: **10-May-2006**



## UNITED STATES PATENT AND TRADEMARK OFFICE

<b>REGISTRATION NO:</b> 2,947,268  <b>REGISTRANT:</b> MONSTERCOMMERCE, INC.	<b>*2947268*</b>
<b>CORRESPONDENT ADDRESS:</b> MATTHEW J. HIMICH THOMPSON COBURN LLP ONE US BANK PLAZA ST. LOUIS, MISSOURI 63101	<b>RETURN ADDRESS:</b> Commissioner for Trademarks P.O. Box 1451 Alexandria, VA 22313-1451
<b>MARK:</b> MONSTERCOMMERCE	May 11, 2006
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b> N/A  <b>CORRESPONDENT EMAIL ADDRESS:</b>	Please provide in all correspondence:  1. Registration date, registration number, mark and registrant's name. 2. Date of this Office Action. 3. Examiner's name and Post Registration Division. 4. Your telephone number and e-mail address.

### POST REGISTRATION OFFICE ACTION

Registration Number 2,947,268

The Section 7(h) Request for Correction submitted on October 27, 2005 is not accepted for the reasons set forth below.

The owner must verify that the contents of the Section 7(h) Request for Correction are true and correct in an affidavit or declaration under 37 C.F.R. §2.20. The submitted request was unsigned or improperly verified.

To verify the Section 7 Request for Correction, the owner must submit a substitute affidavit or declaration under 37 C.F.R. §2.20. The following is a properly worded declaration in accordance with 37 C.F.R. §2.20 that can be inserted at the end of your response, and signed and dated:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statement may jeopardize the validity of this document, declares that s/he is properly authorized to

execute this document on behalf of the owner, and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

\_\_\_\_\_  
Signature of Authorized Person

\_\_\_\_\_  
Type or Print Name

\_\_\_\_\_  
Date

The owner has six months from the mailing date of this letter to respond to all the issues raised in this letter. In order to expedite the processing of your Section 7 Request for Correction, the early submission of a response to this letter is encouraged. If a complete response is not received in the Office within this time period, then the Section 7 Request for Correction will be considered abandoned. 37 C.F.R. §2.176.

Valerie Stevens  
Trademark Specialist  
571-272-9228

**How to respond to this Office Action:**

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the registration number, the words 'Post Registration' and the examiner's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINER.**

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*If you need help:*

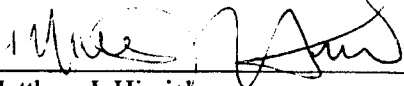
- *Call the Trademark Assistance Center at 571.272.9250 for help on trademark matters.*
- *Send questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).*
- *If you have technical difficulties or problems with this application, please e-mail them to [Electronic Business Support Electronic Applications](#) or call 1 800-786-9199.*

**TRADEMARK**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on October 25, 2005.

  
Matthew J. Himich  
Reg. #47650

In re application of:  
MonsterCommerce, LLC

Reg. No. 2,947,268

Registration date: May 10, 2005

For: MONSTERCOMMERCE

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

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Post-Registration Division

**POST-REGISTRATION AMENDMENT PURSUANT TO 37 C.F.R. §2.173(a)**

COMES NOW MonsterCommerce, LLC, by and through its attorneys Thompson Coburn LLP, and pursuant to 37 C.F.R. §2.173(a), TMEP §1609.10(b), and TMEP §1201.02(c), hereby moves to amend the registration to correct a clerical mistake in the manner in which the name of the registrant is set forth in the registration. The application as filed on August 29, 2002, and subsequently the registration as issued on May 10, 2005, indicates the applicant/registant as Monstercommerce, Inc., a corporation of California. Please amend the registration to indicate that the applicant/registant is MonsterCommerce, LLC, a limited liability corporation of California.

It is believed that this amendment is of the type set forth in TMEP §1201.02(c), and neither republication, a verification nor a declaration is needed.



10-27-2005